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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

STL10953

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37 CFR §1.8(a)

on 07-05-06Signature Diana C. AndersonTyped or printed name Diana C. Anderson

Application Number

10/625,717

Filed

July 23, 2003

First Named Inventor

Mark A. Toffle

Art Unit

2627

Examiner

Brian Miller

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 38,794

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Mitchell K. McCarthy
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Telephone number

7/5/2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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JUL 5 - 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Mark A. Toffle, Xu Zuo, Brent M. Weichelt and Louis J. Fioravanti
Assignee: SEAGATE TECHNOLOGY LLC
Application No.: 10/625,717
Filed: July 23, 2003
For: SERVO TRACK WRITER WITH HELIUM BEARING

Group Art: 2627
Examiner: Brian Miller

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant prays that the Panel's objective review will conclude that the unresolved issues summarized here are not appropriate subject matter for appeal, but must rather be resolved in order to place this case in condition for appeal.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED A PRIMA FACIE CASE OF OBVIOUSNESS BY FAILING TO PROVIDE EVIDENCE THAT THE CITED REFERENCES TEACH OR SUGGEST ALL THE RECITED FEATURES OF CLAIM

11

Claim 11 recites *maintaining separation of opposing bearing surfaces with a working fluid in a gas-lubricated bearing....* Watanabe '189 discloses a roller bearing spindle apparatus. The skilled artisan readily understands that in a roller bearing the separation between opposing bearing surfaces is maintained by each bearing surface being spatially supported in contacting engagement with a roller bearing, such as in the anterior bearings 3a, 3b and posterior bearing 4 in Watanabe '189. Frees '059 generally discloses a method for writing of servo information, but is wholly silent regarding spindle construction.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a)

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Date: July 5, 2006


Signature

Diana C. Anderson
(type or print name of person certifying)

Obviousness under Section 103 is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). If Applicant is incorrect, meaning this case is in fact ready for appeal, then the Panel must find in the underlying facts "substantial evidence" that adequately supports the legal conclusion of obviousness. *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Here the record clearly shows that the Examiner has failed to substantiate a prima facie case of obviousness because Watanabe '189 and Frees '059 do not, neither alone nor combined, teach or suggest all the features of the present embodiments as recited by the language of claim 11. Accordingly, this case is not in condition for appeal until this factual issue is resolved by the Examiner either withdrawing the obviousness rejection or substantiating it factually in the record. Applicant prays the Panel will re-open the merits of this case for that purpose.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED A PRIMA FACIE CASE OF OBVIOUSNESS BY FAILING TO PROVIDE EVIDENCE THAT THE CITED REFERENCES TEACH OR SUGGEST ALL THE RECITED FEATURES OF CLAIMS 1 AND 21

Claims 1 and 21 recite a *gas-lubricated bearing*. Again, Watanabe '189 discloses a roller bearing spindle apparatus, and Frees '059 is wholly silent about spindle construction.

The Examiner would have us now go to appeal to determine whether his reading the claim term *gas-lubricated bearing* onto a roller bearing is within the bounds of construing the claim term "reasonably broad within the usage in the specification." Applicant has repeatedly argued in the record that the Examiner's construction is neither reasonable nor consistent with the specification.

First, Applicant has repeatedly argued in the record, without rebuttal by the Examiner, that the cited references clearly do not teach or suggest a *gas-lubricated bearing* because that claim term is a term of art to the skilled artisan, having ordinary meaning associated with hydrostatic bearings or hydrodynamic bearings, not roller bearings. (see Applicant's Response of 6/5/2006, pg. 8; Applicant's Response of 1/18/2006, ppg. 9-11)

Furthermore, a well recognized tenet of claim construction is that a claim term must be construed consistently in all the claims. Here, claim 11 defines the structure of a *gas-lubricated bearing* in a way that adequately distinguishes it from the roller bearing of the cited reference:

maintaining separation of opposing bearing surfaces with a working fluid in a gas-lubricated bearing.... If the Examiner is correct then the Panel must conclude that the skilled artisan would conclude that in Watanabe '189 the opposing bearing surfaces are maintained in spatial separation by the working fluid; actually, the skilled artisan would find that conclusion absurd because clearly it is the roller bearings doing so.

In rebuttal the Examiner asserted that in order to limit the claim term *gas-lubricated bearing* would require more expressly recited structural features distinguishing over the roller bearing of Watanabe '189. Applicant responded directly to the Examiner's suggestion by amending the claims accordingly in an after-final amendment, only to have them not entered as new language requiring further consideration and/or search. Applicant hopes that the Panel will credit Applicant's proven willingness to amend the claims to obviate the Examiner's rejections in deciding whether to reopen the merits of this case.

Obviousness under Section 103 is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). If Applicant is incorrect, meaning this case is in fact ready for appeal, then the Panel must find in the underlying facts "substantial evidence" that adequately supports the legal conclusion of obviousness. *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Here the record clearly shows that the Examiner has failed to substantiate a prima facie case of obviousness because Watanabe '189 and Frees '059 do not, neither alone nor combined, teach or suggest all the features of the present embodiments as recited by the language of claims 1 and 211. Accordingly, this case is not in condition for appeal until this factual issue is resolved by the Examiner either withdrawing the obviousness rejection or substantiating it factually in the record. Applicant prays the Panel will re-open the merits of this case for that purpose.

Respectfully submitted

By: 

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